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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,509	03/28/2005	Christelle Marie Guittet	05-232	6176
20/306 7590 01/30/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
SIMS, JASON M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,509

Applicant(s)

GUITTET ET AL.

Examiner

JASON M. SIMS

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments, filed 9/24/2008, have been fully considered. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Applicants have amended their claims, filed 9/24/2008, and therefore rejections newly made in the instant office action have been necessitated by amendment.

Applicant's cancellation of claims 6, 12, and 18 in the response filed 9/24/2008 is acknowledged.

Claims 1-5, 7-11, and 13-17 are the current claims hereby under examination.

Claim Rejections - 35 USC § 112

Response to Arguments:

Applicant's arguments, filed 9/24/2008, with respect to the rejections of claims under 35 USC 112 second paragraph have been fully considered and are persuasive because of applicant's amendments and arguments. Therefore the rejections have been withdrawn.

The following rejections are being newly applied:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-11, and 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, and 13 (and all claims dependent therefrom) comprise two seemingly conflicting steps, step b) and step d), substep ii), which together have been deemed as vague and indefinite. Step b) requires finding second objects in a image having pixel value characteristics of fat and holes within tubules, wherein step d), substep ii) counts the first objects having the selected second objects within them as tubules. It is unclear as to what the word "characteristics" refers with regards to identifying objects with pixel value "characteristics" of fat and holes. It is unclear because if objects selected with pixel value characteristics of fat and holes, such as brighter pixel values not bordering dark boundaries, then they would not be counted as potential tubules. It is unclear as to how "characteristic" the pixel values are, wherein pixel values truly "characteristic" of fat and holes will not be counted as potential tubules. Therefore it is unclear as to how "characteristic" the pixel values should be, but yet not actually be pixel values that are values for true fat and holes, wherein the selected objects will still be counted as tubules. Clarification via clearer claim wording is required.

Furthermore, step b) states that these second objects are "within tubules," wherein step d), substep ii) requires counting first objects having selected objects as "likely to be tubules," which causes said steps to be vague and indefinite. The first objects identified are potential tubules, not necessarily tubules, wherein the second

objects are "within tubules," but when found to exist inside the first objects become "likely tubules." The said steps are vague and indefinite as to when identified objects are necessarily tubules or are potential or likely tubules. Clarification via clearer claim wording is required.

Claim Rejections - 35 USC § 101

Response to Arguments:

Applicant's arguments, filed 9/24/2008, with respect to the rejections of claims under 35 USC 101 as being drawn to non-statutory subject matter have been fully considered and are persuasive because of applicant's amendments and arguments. Therefore the rejection has been withdrawn.

The following rejection is being newly applied with new analysis:

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 13-17 are rejected under 35 U.S.C. 101 because these claims are drawn to non-statutory subject matter.

Claims 1-5 are drawn to a process. A process is statutory subject matter under 35 U.S.C. 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms an article to a different state or thing (In re Bilski, 88 USPQ2d 1385 Fed. Cir. 2008).

The claimed subject matter of claims 1-5 is not limited to a particular apparatus or machine. To qualify as a statutory process, the claims should require use of a

machine within the steps of the claimed subject matter or require transformation of an article to a different state or thing. Insignificant extra-solution activity in the claimed subject matter will not be considered sufficient to convert a process that otherwise recites only mental steps into statutory subject matter (*In re Grams* 12 USPQ2d 1824 Fed. Cir. 1989). Preamble limitations that require the claimed process to comprise machine implemented steps will not be considered sufficient to convert a process that otherwise recites only mental steps into statutory subject matter. The applicants are cautioned against introduction of new matter in an amendment.

Claims 13-17 are drawn to a computer program on computer readable media. A review of the specification does not show a definition of computer readable media such that excludes an embodiment that is information in a signal. As such an embodiment of the claims read on non-statutory subject matter (*In re Nuijten* 84 USPQ2d 1495 (2007)). The applicants may overcome the rejection by amendment of the claims to be limited to physical forms of computer readable media described in the specification, or if no description exists for physical computer readable media, by presenting a statement that the claims do not read on embodiments that are not physical computer readable media that are conventional in the art.

The following rejection is being newly applied:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 9-11, 13, and 15-17 rejected under 35 U.S.C. 102(b) as being anticipated by Cheng et al. (Submitted on IDS filed 7/25/2005).

The claims are drawn to a method of grading tubules in a first image of a histological slide, the method having the steps of:

a) providing a second image of first objects in the first image which are sufficiently large and of appropriate pixel value characteristics at boundaries to potentially be tubules,

b) providing a third image of second objects in the first image having pixel value characteristics of fat and holes within tubules,

c) combining data from the second and third images to identify selected second objects which are within first objects,

d) performing one or more of the following:

i) counting first objects in the first image which may potentially be tubules to provide a parameter NOB,

ii) counting the first objects having selected second objects within them and likely to be tubules to provide a parameter N,

iii) determining the relative areas of selected second objects as proportions of respective first objects within which they are located to provide parameters RATIO,

iv) determining the total area of selected second objects as a proportion of total area of first objects within which they are located to provide a parameter SURF,

v) determining a parameter $PERCENT = N/NOB$, and

vi) counting the number of first objects containing at least medium sized holes to provide a parameter T, and

e) grading the first image's tubules on the basis of the one or more parameters as aforesaid with reference to parameter threshold values.

Cheng et al. at the abstract teach a method of grading tubules in digitized images of microscopic slides, which reads on the preamble of the instantly claimed method. Cheng et al. at page 323, part B. teach identifying pixel value characteristics that potentially may be tubules, which reads on part a). Cheng et al. at page 323, step C. and page 324 teach a method of making a third image wherein each of the first identified potential tubules, i.e. objects, are further analyzed to identify pixel values of likely tubules, which reads on steps b) and c). Cheng et al. reads on step b) because the pixel values, which indicate a potential tubule are also pixel values characteristic of fat and holes, i.e. rough textures. For example, Cheng et al. at page 324, last paragraph states that tubules and rough textures, both comprise homogeneous areas, wherein the pixel values of the homogeneous areas of tubules reads on the broad and reasonable interpretation of pixel value characteristics of fat and holes, which are comprised of similar homogeneous areas. Furthermore, the analysis taught by Cheng et al. step C, is performed on the initial first objects wherein the first objects are potential

or likely tubules and whose pixel values are characteristic of fat and holes. Cheng et al. at page 326, step D, teach a method of counting the tubule areas and using the counting to obtain a score for physicians, which reads on step d), substep ii), step e), and step f). With regards to claims 7 and 13 directed to an apparatus and instructions, i.e. program, Cheng et al. teach a computer system for implementing the algorithms, wherein the computer executing the algorithms inherently comprises the instructions on a computer readable medium at pages 327 and 328.

Cheng et al. at pages 323-328 teach wherein bright area pixels have different binary values than darker areas as in claims 3, 9, and 15.

Cheng et al. teach claims 4, 10, and 16 at page 328.

Cheng et al. at page 326, step D., teach grading tubules comparable with that of a physician, i.e. medical expert as claims 5, 11, and 17.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is (571)-272-7540.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marjorie Moran can be reached via telephone (571)-272-0720.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

// Jason Sims //

/Michael Borin/
Primary Examiner, Art Unit 1631